



JJGJr.:12-01

Paper 8

ROBERT KINBERG
VENABLE BAETJER
HOWARD & CIVILETTI, L.L.P.
P.O. BOX 34385
WASHINGTON, DC 20043-9998

COPY MAILED**JAN 11 2002****OFFICE OF PETITIONS**

In re application of
Dombek
Application No. 09/775,638
Filed: 5 February, 2001
Attorney Docket No.: 31512-168230RK

ON PETITION

This is a decision on the request for a corrected filing receipt filed on 30 August, 2001, and the petition filed (with the applicable fee) on 13 November, 2001, as an untitled response to a Notice of Omitted Items, both treated herein under the provisions of 37 C.F.R. §1.53 (e)¹ to accord a filing date of 5 February, 2001, to page 32 of the specification.

The petition is **DISMISSED in part and GRANTED in part.**

The record indicates that:

- the instant application was deposited on Monday, 5 February, 2001, and page 32 of the specification was not included with other items of the application;
- a filing receipt was mailed by the Office on 30 April, 2001, indicating the application claimed priority to German Application Number 100 04 908.7 02/04/2000;
- Petitioner filed on 30 August, 2001, a request for a corrected filing receipt reflecting the additional priority to German Application Number 100 04 906.0 02/04/2000;
- a Notice of Omitted Items was mailed on 22 October, 2001, stating that page 32 of the specification was not filed contemporaneously with the application, and that the filing date would be the date of receipt of the omitted page of specification;
- the instant petition was filed in response on 13 November, 2001, including therewith page 32 of the specification.

Petitioner submits with the petition, *inter alia*:

¹ The regulation at 37 C.F.R. §1.53(e) provide:

§ 1.53 Application number, filing date, and completion of application.

(e) Failure to meet filing date requirements.

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a time period within which to correct the filing error.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.

- an unlabeled exhibit, appearing to be page 32 of the specification for the instant application containing the following three lines:

desirable characteristics of the ultimate products and
without causing a reductio of the output of machines
or production lines for the making of such products.
- an unlabeled exhibit, appearing to be a transmittal receipt dated by Petitioner and stamped as received by the Office on 5 February, 2001, and thereon containing an itemization of elements including "New Patent Application, (43 Pages)/specification claims and abstract[.]"

Notably:

- a review of the application, and in particular the top of each page of the specification as filed, clearly indicates that the body of the application was transmitted by FAX on "01/02/2001" from telephone number "+48-40-30974444" from a source identified as ESP HAMBURG";
- moreover, the pages were sequentially transmitted such that atop each page of the specification as filed a clear enumeration specifies page 1 of the application is page 3 of the FAX, page 2 of the application is page 4 of the FAX--and that sequence continues until page 31 of the application page is page 33 of the FAX, however (as noted above page 32 of the application is missing and) page 33 of the application is page 34 of the FAX; and
- unlike the other 42 pages of the 43-page application, the page numbered 32 submitted by Petitioner has no FAX transmission information atop the page.

Therefore, the record evidence thus far is contradictory, and a simple submission of the stamped receipt card does not confirm that page 32 was in fact received by the Office.

A return postcard receipt serves as *prima facie* evidence that the identified papers were or were not received by the Office. MPEP § 503.² However, *prima facie* evidence can be controverted by other evidence in the record.

While the Office does not doubt that the specification and claim(s) were prepared for submittal in February 2001, the mere fact that they were prepared and readied for mailing/delivery does not necessarily mean that they were included with the application papers filed with the Office on 5 February, 2001.³

² MPEP § 503 provides in pertinent part as follows:

[T]he postcard receipt will not serve as *prima facie* evidence of receipt of papers which are not adequately itemized...Instead, each separate component, e.g., the number of pages of specification, number of claims (nonprovisional applications), number of sheets of drawings, cover sheet (provisional applications), etc. should be itemized on the postcard receipt...A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

³ MPEP § 513 provides in pertinent part as follows:

Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 C.F.R. §1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the

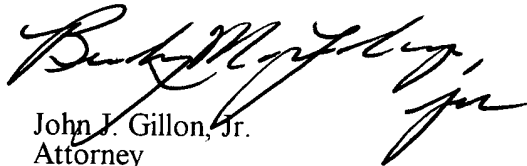
Accordingly:

- the Office cannot grant a 5 February, 2001, filing date for page 32 of the specification of the instant application, and as to that request the petition **is dismissed**;
- the priority claim to German Application Number 100 04 908.7 02/04/2000 and German Application Number 100 04 906.0 02/04/2000 were made at application and as to that request for a corrected filing receipt, the petition **is granted**.

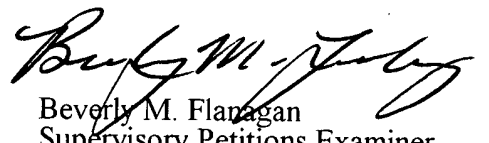
Therefore, this application is being forwarded to OIPE for further processing with:

- a filing date of 5 February, 2001;
- a corrected filing receipt is to issue reflecting the priority claim to German Application Number 100 04 908.7 02/04/2000 and German Application Number 100 04 906.0 02/04/2000.

Telephone inquiries concerning this matter should be directed to John J. Gillon, Jr., Attorney, Office of Petitions, at (703) 305-9199.



John J. Gillon, Jr.
Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

application), an applicant may not rely upon the provisions of 37 C.F.R. §1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP §503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.